

REMARKS

Amendments to the Claims

Applicant has canceled claims 4 and 14 herein. Applicant reserves the right to pursue canceled subject matter in any patent application that claims the benefit of priority of the instant application.

Applicant has amended claim 11 solely to correct an inadvertent typographical error. Applicant respectfully requests that the amendment be entered.

In sum, upon entry of this Response, claims 4 and 14 will be canceled, and claims 1-3, 5,7-8, 11-13, 15, 17-18, and 21-24 will be pending.

THE OFFICE ACTION

The Objections to the Drawings

The Office Action has objected to the drawings, alleging that the recess on the second portion, as claimed in claims 4 and 14 must be shown or the features canceled from the claims. The Office Action suggests that the recess on the second portion is not shown. In response, Applicant has canceled claims 4 and 14, rendering the objection to the drawings moot.

The Rejections Under 35 U.S.C. § 103(a)

The Claims are Not Obvious Over Kliot in view of Stager; further in view of Bystrom or Franges; and further in view of Morris

The Office Action has rejected claims 1, 5, 11 and 16 as allegedly unpatentable over U.S. Patent No. 5,431,317 issued to Kliot ("Kliot" hereafter) in view of U.S. Patent Application Publication No. 2003/0028136 in the name of Stager ("Stager" hereafter). The Office Action contends that Kliot teaches the prior art attachment for straps that includes a pair of fasteners on first and second ends that may comprise hook and loop material as implied in claims 9 or 19 or snap fasteners. The Office Action admits that Kliot does not suggest the use of magnets, but contends that the substitution of magnets for conventional snap fasteners in wraps for ease of fastening is well known as taught by Stager. The Office Action concludes that to have substituted magnetic snaps having magnets for the snap fasteners of Kliot would have been obviousness to one ordinarily skilled in the art.

Further, the Office Action has rejected claims 2, 4, 12, 14, 21 and 23 under 35 U.S.C. § 103(a) over the references as applied to claims 1 and 11, further in view of Bystrom or Franges, both of which were made of record in the Office Action mailed September 27, 2005. The Office Action contends that, to have provided a recess in one portion of the attachment to receive the contacting portion to provide a smooth contact area would have been obvious in view of Bystrom or Franges.

Finally, the Office Action has rejected claims 3, 7, 8, 13, 17-18, 22 and 24 under 35 U.S.C. § 103(a) over the references as applied to claims 1, 2, 11 and 12, in view of Bystrom or Franges, and further in view of Morris, which was made of record in the prior Office Action mailed September 27, 2005. The Office Action contends that, to have alternatively embedded a magnet between layers to provide a smooth fastening surface would have been obvious in view of the disclosure of Morris.

Applicant respectfully traverses these rejections.

“To establish a *prima facie* case of obviousness ... there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.” MPEP § 2143.

Applicant respectfully submits that Kliot does not disclose or suggest all of the features of the attachment to a strap, or a bag for holding articles, of pending independent claims 1 and 11, respectively. Kliot is directed to a multimode traveling bag and discloses an “attachment for straps which includes a pair of fasteners on first and second ends which may comprise hood and loop materials.” And, as the Office Action admits, Kliot does not suggest the use of magnets. But, the Office Action suggests that Stager discloses the use of magnets for conventional snap fasteners in wraps.

Applicant submits that the instant invention is directed to, among other things, an attachment to a strap and a bag for holding articles. By contrast, Stager is directed to a wristpad apparatus worn by a person using a computer keyboard, and to devices adapted to support a person's wrist as the keyboard is used. *See*, Stager, paragraph [0002]. As further disclosed in Stager, the flexible wristband **12** includes a first wristband strap portion **54** which may include a first strap connector **56** and the second strap connector **60** may include magnets, adhesives,

buttons, snaps, zippers, clips, and latches, among other connecting means. *See*, Stager, paragraph [0060].

Applicant respectfully submits that nowhere in Stager is it disclosed or suggested to adapt a magnet connecting means of the wristband strap of Stager with a strap connecting means for an attachment to a strap or for a bag for holding articles including an attachment to a strap. Thus, the necessary motivation or suggestion to combine the connector of Stager's wristpad with the teaching of Kliot is absent. Moreover, as discussed above, the Examiner admits that Kliot does not disclose the missing feature. Accordingly, at least for these reasons, Applicant respectfully submits that the Office Action has not met its burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). As such, Applicant submits that claims 1, 5, 11 and 16 are patentable over the prior art of record.

Moreover, Applicants submit that Bystrom or Franges have been cited only for the teaching of "a recess in one portion of the attachment to receive the contacting portion to provide a smooth contact area." Applicant submits that neither Bystrom nor Franges disclose or suggest any of the aforementioned features of independent claims 1 and 11 missing from Kliot and Stager, and have not been so cited. And, since Kliot and Stager do not teach or suggest the independent claims 1 and 11, Applicant submits that there is no motivation to combine the teachings of Bystrom or Franges to arrive at the claimed invention. Thus, Applicant submits that claims 2, and 12, 21 and 23, which are dependent upon claims 1 and 11 respectively, are not rendered obvious by the combination of the Kliot and Stager with Bystrom or Franges.

Finally, as discussed above, Kliot taken with Stager does not render obvious the claimed invention of claims 1 and 11, since Stager provided no motivation to combine its disclosure with Kliot. In view of this absence, Applicant further submits that Morris does not cure the deficiencies of Kliot and Stager, taken with Bystrom or Franges.

Furthermore, Applicant respectfully submits that Morris, like Stager, fails to address the problem that the instant application addressed: an attachment to a carrying strap that makes carrying baggage more comfortable and convenient for a user. *See*, paragraph [0001] of the present application. Morris addresses "cases of the pocket-size variety which are attachable to one's apparel," and for fastening the *flap* thereon. *See*, Morris, col. 1, lines 10-11, and Figs. 1-6. The instant application, however, concerns "an attachment to a *strap*." Morris addressed different design, manufacturing, and usability considerations, as it dealt with magnetic fasteners

that retain items inside of pocket-size cases. By contrast, the instant application is directed to design, manufacturing and usability considerations with respect to keeping an attachment closed around a strap. Morris addressed an entirely different problem than Applicant in the instant application. Morris can not be combined with the Kliot reference under 35 U.S.C. § 103.

Moreover, as discussed above, there is no suggestion in any of the prior art of record that they be combined in the manner proposed by the Office Action. Absent such a suggestion, there would be no reason why one skilled in the art, faced with the same problem confronting Applicant and who had no prior knowledge of Applicant's claimed structure, would consult the particular combination of references suggested by the Office Action.

Furthermore, Morris has been cited only for disclosing an "embedded magnet between layers." Morris does not disclose or suggest any of the aforementioned features of parent claims 1 and 11 missing from Kliot and Stager, and has not been so cited. Thus, claims 3, 7, and 8, and claims 13, 17-18, 22 and 24, which depend upon claims 1 and 11, respectively, are not rendered obvious by the combination of Kliot and Stager in view of Bystrom or Franges with Morris.

At least for the above reasons, Applicant respectfully submits that the Office Action has not met its burden of establishing a *prima facie* case of obviousness under 35 U.S.C. § 103(a). Accordingly, Applicant respectfully requests that the rejections be withdrawn.

Formal Request for Interview

Applicant submits that the present application is in condition for allowance at least for the reasons set forth herein. If the present application is not considered to be in condition for allowance by the Examiner, and pursuant to M.P.E.P. § 713.09, Applicant requests an interview with the Examiner to discuss the present application and the prior art of record. Applicant's Attorney, Gary M. Butter, may be reached by telephone at (212) 408-2546 to schedule a mutually convenient date and time and to provide assistance or additional information as required.

Conclusion

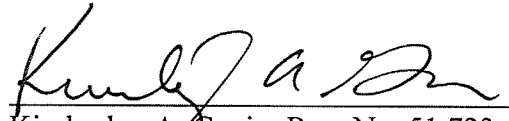
On the basis of the foregoing Remarks, Applicant respectfully submits that the pending claims of the present application are allowable over the prior art of record. Applicant

thus respectfully requests that the Examiner enter this Response, and withdraw the rejections of the pending claims.

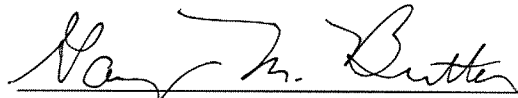
Applicant submits that this Response does not raise new issues for consideration or necessitate the undertaking of any additional search of the art by the Examiner because all of the elements and their relationships were either earlier claimed or inherent in the claims as examined. This Response should therefore allow for immediate action by the Examiner.

In addition to the fee for a three (3)-month extension of time, Applicant believes that no additional fee is due in connection with the filing of this Response. However, Applicant authorizes, in the Fee Transmittal Form the Director to charge payment of any additional fees or credit any overpayment associated with this Response to Deposit Account No. 02-4377.

Respectfully submitted,



Kimberley A. Gavin, Reg. No. 51,723
Agent for Applicants



Gary M. Butter, Reg. No. 33,841
Attorney for Applicants

BAKER BOTTS L.L.P
Customer No. 21003